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JAMES H. McKENNEY,
Clerk

Supreme Court of the United States.

UNITED STATES ON THE RELATION OF STEINMETZ,

vs.

FREDERICK I. ALLEN, Commissioner of Patents.

No. 383.

MEMORANDUM FOR PETITIONER.

I. The petitioner is entitled to a mandamus if he is unjustly deprived of an appeal from an adverse decision or has been otherwise deprived of any other substantial right.

II. If the twice repeated refusal of the Examiner to proceed with the examination of the Steinmetz application unless and until the applicant shall have cancelled Claims 7 to 13 (or shall have converted *one* application into *two)* is not authorized by law, and if the refusal of the Examiner to allow an appeal from this decision be not authorized by law, then the petitioner has been deprived of a substantial right and is entitled to a mandamus.

The Commissioner justifies his action under his power to make rules, and alleges rule 41 as the justification of his action. The petitioner denies the legality of that Rule. The validity of that Rule and of the authority to make it is thus brought in question on this appeal.

III. The Examiner seeks to justify his action by Rule 41 of the Patent Office.

This rule allows two inventions to be joined in a single application if "dependent" on each other and mutually contribute to a single result.

But the Examiner has declined even to consider whether this condition does or does not exist.

He refuses to proceed because Rule 41 has, *since the Steinmetz application was filed*, been supplemented by a post-script to the effect that Claims for a machine and for its process *must* be patented separately.

(1) Does the law *require* this? Clearly not, for no such requirement of law is cited or asserted.

(2) Has the law given to the Commissioner power to arbitrarily make and enforce this rule irrespective of the question whether the invention of machine and process are "mutually dependent" or not? The power conferred by law to make rules clearly does not include the making of rules which jeopardize the rights of inventors. There is nothing in the law which authorizes the Commissioner or Examiner absolutely, and without remedy by appeal, and without considering the special invention before them, to compel the inventor of a machine and of its process (or method) to apply for and take two patents instead of one?

It is to be clearly noted that this is not a case where the Commissioner or the Examiner has looked into the application in question and has decided that its special character is such that *it* ought to be divided. Nor is the case one where the Commissioner exercises or has undertaken to exercise his "discretion" in ordering *this particular* application to be divided. But he and the Commissioner, without considering this particular application, have, since it was filed, promulgated a new or amended rule which the Examiner has enforced by declining to act until it is complied with, to the effect that an apparatus or machine and its method *cannot* be united in one application.

The Examiner refuses to proceed with the case until a division has been made, or Claims 7 to 13 cancelled, *no matter what jeopardy to the inventor's rights may thereby ensue.*

IV. That there is jeopardy to the inventor's rights is fully proved. The principal brief for the petitioner (p. 26–27) shows that the practice of arbitrary divisions of applications has endangered the rights of inventors and has not yet received the approval of the courts.

It is sufficient in the present case to say that jeopardy exists even though it may be ultimately claimed that the inventor's rights may not be wholly sacrificed.

The case of *Underwood* v. *Gerber*, 149 U. S. 224, is conclusive that there is grave danger in the practice of separating an invention by attempting to cover it by two patents instead of one, even though those patents are dated on the same day and numbered with successive numbers.

V. That process and apparatus may be rightly joined in a single application, and that these difficulties may thereby be avoided, is fully established by the decision in this Court in the Telephone Cases, 126 U. S., p. 1.

VI. That in the present case the process and apparatus are in fact closely related to each other and probably "dependent" on each other, if not inseparable, sufficiently appears to justify the assumption, at least for the purposes of this case, that they ought not to be required to be *arbitrarily*, and without special reason, separated from each other.

VII. The question in this case, therefore, comes to this:

Does the law confer upon the Commissioner power to make an arbitrary rule of separation such as he has done by the amendments (*ex-post-facto*) to Rule 41?

No case has been cited supporting the legality of any such power. This is not the making of a rule merely to regulate practice. It is a rule which impairs rights.

No section or words of the law are invoked to justify the exercise of such power.

VIII. If the Examiner is without clear authority in law for his refusal to proceed, then his action amounts to a refusal of the application, because to insist upon unreasonable or unauthorized conditions, is, of course, equivalent to a refusal.

IX. If the Examiner's action is equivalent to a refusal of the application, and inasmuch as it has been twice repeated, it is clear that it amounts, in substance, to an "adverse decision" and is equivalent to an "adverse decision on the merits."

This being the case, the petitioner is clearly entitled to his appeal and the Commissioner and Examiner have unjustly deprived him of a substantial right by refusing to allow such appeal.

Respectfully submitted,

FREDERIC H. BETTS,
Counsellor for Petitioner.